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| APPLICATION NO.                                                                                               | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
|---------------------------------------------------------------------------------------------------------------|-------------|----------------------|--------------------------|------------------|
| 10/043,493                                                                                                    | 01/14/2002  | John D. Polk         | 06556.0039               | 9208             |
| 22852                                                                                                         | 7590        | 04/11/2008           | EXAMINER                 |                  |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER<br>LLP<br>901 NEW YORK AVENUE, NW<br>WASHINGTON, DC 20001-4413 |             |                      | CHEUNG, MARY DA ZHI WANG |                  |
| ART UNIT                                                                                                      |             | PAPER NUMBER         |                          | 3694             |
| MAIL DATE                                                                                                     |             | DELIVERY MODE        |                          | 04/11/2008 PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/043,493             | POLK ET AL.         |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | MARY CHEUNG            | 3694                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 January 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 201,203-217,219-234,267 and 268 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 201, 203-217, 219-234 and 267-268 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the RCE filed on January 30, 2008. Claims 201, 203-217, 219-234 and 267-268 are pending. Claims 1-200, 202, 218 and 235-266 are canceled. Claims 201, 203-204, 217, 219-220, 233-234 and 267-268 are amended. All pending claims are examined.

### ***Response to Arguments***

2. Applicant's arguments filed January 30, 2008 have been fully considered but they are not persuasive.

The applicant argues that cited prior art fail to teach "verifying the employee information using verification information received from an intermediary" as claimed in all independent claims. As shown in the office action below, Embrey (US 6,311,170 B1) teaches the trusted financial institution uses the verification information received from the payee to verify the payor information, and process the disbursement between the payor and the payee if the information is positively verified (column 3 lines 49-55 and Fig. 4), that corresponds to this limitation. The applicant further argues that purpose of verification in Embrey's teaching is different from the claimed invention. Examiner believes that regardless the purpose of verification, Embrey's teaching reads on the claimed limitation.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 201, 203-207, 209, 212, 214-217, 219-223, 225, 228, 230-234 and 268 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn et al., US 6,401,079 B1 in view of Embrey, US 6,311,170 B1.

As to claim 201 and 203-204, Kahn teaches a method for processing payments over a network for a plurality of intermediaries, comprising (abstract and column 11 line 59 – column 12 lines 10 and column 12 lines 45-60 and Fig. 3; “*intermediaries*” corresponds to the *miscellaneous payees* in Kahn’s teaching, such as *child support agencies*):

- Receiving employee information from a plurality of employers via network, the employee information corresponding to at least one employee of each employer and including an intermediary identifier (column 5 lines 36 – column 6 line 7 and column 11 line 59 – column 12 line 10 and column 12 lines 45-60);
- Processing at least one employee debit corresponding to the employee information for each employee (column 11 line 59 – column 12 line 10 and column 19 lines 12-32 and Fig. 3);
- processing a credit corresponding to each employee debit (column 19 lines 12-36 and Fig. 3);

- batching the credits into a plurality of batch files based upon the intermediary identifier, each batch file including intermediary-requested data (column 19 lines 12-67 and column 39 lines 10-24 and Fig. 3); and
- sending each batch file, including the intermediary-requested data, to an intermediary based on the intermediary identifier (column 19 lines 12-67 and column 39 lines 10-24 and Fig. 3).

Kahn does not specifically teach verifying the employee information using verification information received from an intermediary, processing the employee debit corresponding to the employee information for each employee, when the employee information is verified, and receiving a credit corresponding to the employee debits, when the employee information is verified. However, this matter is taught by Embrey as the trusted financial institution uses the verification information received from the payee to verify the payor information, and process the disbursement between the payor and the payee if the information is positively verified (column 3 lines 49-55 and Fig. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kahn's teaching to include the feature of process the disbursement between the payor and payee upon the positively verification by using the verification information received from the payee as taught by Embrey for preventing fraudulent transactions.

As to claim 205, Kahn teaches delivering each batch file to each intermediary using a communication method matching the intermediary identifier (column 19 lines 12-52 and column 39 lines 10-24).

As to claim 206, Kahn teaches the communication method is electronic funds transfer (column 19 lines 12-52 and column 39 lines 10-24).

As to claim 207, Kahn teaches the communication method is electronic data interchange (column 19 lines 12-52 and column 39 lines 10-24).

As to claim 209, Kahn teaches the network is the Internet (Fig. 1).

As to claim 212, Kahn teaches the network is a wired network (Fig. 1).

As to claim 214, Kahn teaches the employee information relates to a child support payment (column 12 lines 45-60).

As to claim 215, Kahn teaches the debits are processed using debit-based electronic funds transfer (column 19 lines 12-32).

As to claim 216, Kahn teaches the credits are processed using addendum-based electronic data interchange (column 6 line 19-23 and column 19 lines 43-52 and column 51 lines 14-30 and Fig. 3).

As to claim 268, Kahn teaches batching debits from each employer, each batch file representing a debit against the bank account of the employer; storing the information used to create the batched credits and debits, allowing changes to the information by an authorized person; recalculating the batch file when changes are made; resending the debit batch file to the bank of the employer, if necessary; and resending the credit batch file to the intermediary, if necessary (column 5 lines 25-35 and column 12 lines 11-44 and column 19 lines 13-67).

Claims 217, 219-223, 225, 228 and 230-234 are parallel with the limitations in claims 201, 203-207, 209, 212 and 214-216; thus, they are rejected on the same basis.

5. Claims 208, 210-211, 213, 224, 226-227 and 229 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn et al., US 6,401,079 B1 in view of Embrey, US 6,311,170 B1, and in further view of Official Notice.

As to claims 208, 210-211, 213, 224, 226-227 and 229, Kahn modified by Embrey does not specifically teach the communication method is paper, the network is an intranet, the network is a wireless network, and the network is a virtual private network. Examiner takes Official Notice for these limitations. It would have been obvious to one of ordinary skill in the art to allow Kahn's teachings to implement these features because by implementing these well known in the art features would better meet the users'/employers' needs for attracting more people to use the modified Kahn's payroll system.

6. Claim 267 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn et al., US 6,401,079 B1 in view of Embrey, US 6,311,170 B1, and in further view of Fulton et al., US 6,182,052 B1.

As to claim 267, Kahn modified by Embrey teaches batching the debits from each employee, each batch file representing a debit against the bank account of the employee; submitting the debit against the bank account of the employee via a financial clearinghouse based on instructions received from the employer; and receiving a credit for each intermediary corresponding to the debit from the financial clearinghouse, if the debit is applied successfully against the bank account of the employer at the employer's bank (Kahn: column 12 lines 11-44 and column 19 lines 13-42). Kahn modified by Kahn does not specifically teach handling a return received from the financial clearinghouse if

the debit was not successfully. However, this matter is taught by Fulton as receiving error message from the clearinghouse if the debit is not successful (column 5 line 63 – column 6 line 2 and column 10 lines 12-17). It would have been obvious to one of ordinary in the art at the time the invention was made to allow the teaching of Kahn modified by Embrey to include the feature of handling a return received from the financial clearinghouse if the debit was not successfully for allowing the unsuccessful debit transaction to be notified.

***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 201, 203-217, 219-234 and 267-268 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-48 of U.S. Patent No. 5,946,669. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose disbursement between an employee and a recipient.

9. Claims 201, 203-217, 219-234 and 267-268 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-70 of U.S. Patent No. 6,119,107. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose disbursement between n an employee and a recipient.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to

7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300 (Official Communications; including After Final Communications labeled "BOX AF")

(571) 273-6705 (Draft Communications)

/Mary Cheung/  
Primary Examiner, Art Unit 3694  
April 8, 2008